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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,684	11/25/2003	Andrew Wallace	P27,267-A USA	6154
23307	7590	04/04/2005	EXAMINER	
SYNNESTVEDT & LECHNER, LLP			NGUYEN, CAM N	
2600 ARAMARK TOWER			ART UNIT	
1101 MARKET STREET			PAPER NUMBER	
PHILADELPHIA, PA 191072950			1754	

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/721,684	<b>Applicant(s)</b> WALLACE ET AL.	
	<b>Examiner</b> Cam N Nguyen	<b>Art Unit</b> 1754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/25/03 (a CIP of appl. 10/303,977).
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>05/10/04, 07/12/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 1-78 are objected to because of the following informalities:
  - A. In claims 1-78, line 1, it is suggested that applicants change the phrase "catalyst system" to --catalyst structure--.
  - B. In claims 1, 3, 7-11, 21-24, 31-33, 37-38, 40, 42-43, & 45, 68, 70-73, 75, 77, the word "aluminium" should be changed to --aluminum--.
  - C. In claims 1 & 46, line 4-5, the phrase "excepting the combination of germanium and lithium only" is suggested change to --except for a combination of germanium and lithium--.
  - D. In claims 9-45, 53-67, & 70-72, it is suggested that applicants insert a comma -- , -- after each range of each different metal contents for better read.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112 (Second Paragraph)***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 2-45, 47-67, & 69-78 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 47, & 69 recite the limitation "the monomer" in line 1-2. There is insufficient antecedent basis for this limitation in the claim.

### ***Double Patenting***

4. Claims 1-45 of this application conflict with claims 1-45 of Application No. 10/303,977. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

### ***Claim Rejections - 35 USC § 101***

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

***Claim Rejections - 35 USC § 102(a)***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1-3 are rejected under 35 U.S.C. 102(a) as being anticipated by Otto et al., "hereinafter Otto", (US Pat. 6,417,320 B1).

Otto discloses a composition consisting of a carrier and a catalyst wherein (a) the catalyst consists essentially of one or more polyester-catalyzing compounds, wherein each polyester-catalyzing compound independently comprises a metal selected from the group consisting of Ti, Sb, Ge, Sn, and Al; and (b) the carrier comprises porous, fine grain particles with surfaces and pores for adsorption of the polyester catalyst (see col. 10, claim 1).

It is considered chosen more than one metal compounds from the group of metals disclosed above including a combination of Ge and Al would inherently meet the instant claims, thus the claims are anticipated by the reference.

***Claim Rejections - 35 USC § 102(b)***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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9. Claims 1-4, 8, 46-48, & ~~75~~<sup>73</sup>-76 are rejected under 35 U.S.C. 102(b) as being anticipated by reference XP-002271960 (or JP2001226474), "hereinafter ref '960".

Ref '960 discloses a polyester which is manufactured using germanium compound as catalyst, 0.001-0.5 mol% of compound containing element chosen from aluminum, silicon, iron, strontium, zirconium, tungsten, tin and lead, which is added to the acid component of the polyester (see abstract).

Regarding claims 1-4, & 8, Ref '960 discloses a compound containing elements including germanium, aluminum, and silicon that applicants claiming, thus anticipates the claims.

Regarding claims 46-48, the claims are met by the teaching of the reference because a combination of germanium and silicon is taught to be suitable (see above).

***Claim Rejections - 35 USC § 102(b)***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-3, 6, 8, 46-47, 50, & ~~75~~<sup>73</sup>-76 are rejected under 35 U.S.C. 102(b) as being anticipated by reference XP-002271961 (or JP2000154242), "hereinafter ref '961".

Ref '961 discloses a condensation polymerization catalyst which comprises a

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germanium compound and a compound which is an aluminum, barium, cobalt, magnesium, manganese, strontium, zinc, or a phosphorus compound (see abstract).

Ref '961 discloses catalyst comprises a compound containing elements including germanium, aluminum, and manganese that applicants claiming, thus anticipates the claims.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 7-8, 51-52, 68-69, & 77-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Pat. JP 2000302854A (hereinafter Japanese '854).

Japanese '854 discloses a polyester polymerization catalyst which comprises an aluminum compound and a metal compound, and the metal compounds is a compound selected from a group of metals including lithium, germanium, and manganese (see abstract).

It would have been *prima facie obvious* to one of ordinary skill in the art at the time the invention was made to have selected the specific metals from a group of metals disclosed by the reference, such as a combination of Ge, Al, Li, & Mn to achieve desired catalyst since these metals are taught to be suitable.

***Claim Rejections - 35 USC § 102(b)***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1-2, 5, 46-47, 49, & <sup>73</sup>~~75~~-76 are rejected under 35 U.S.C. 102(b) as being anticipated by Shaw et al., "hereinafter Shaw", (US Pat. 4,378,309).

Shaw discloses a catalyst composition containing Mo, Ge, and other metal components (see col. 4, claim 1).

Shaw teaches a catalyst composition including the claimed metal components, thus anticipates the claims.

***Allowable Subject Matter***

16. Claims 9-45, 53-67, & 70-72 are not being rejected under the art rejection because they contain allowable subject matter.

The prior art does not disclose a catalyst containing the claimed metal components having the claimed metal concentrations.

There is no motivation to combine the teachings of the references together.



***Citations***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 Form prepared attached. All references are cited for related art.

***Conclusion***

18. Claims 1-78 are originally pending in the application. Claims 1-78 are rejected. No claims are allowed.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Cam N Nguyen, whose telephone number is 571-272-1357. The examiner can normally be reached on M, W, R, & F, 8:45 AM - 5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nguyen/cnn  
March 20, 2005

*Cam Nguyen*  
CAM N. NGUYEN  
PRIMARY EXAMINER  
*AV-1754*